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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,593	01/30/2001	Marshall Medoff	08895-019001 FIBROUS MATE	2374

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EXAMINER	
NUTTER, NATHAN M	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/772,593	MEDOFF ET AL.	
	Examiner	Art Unit	
	Nathan M. Nutter	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-17,45-51,54-57 and 60-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-17,45-51,54-57 and 60-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 03-06
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 March 2006 has been entered.

Information Disclosure Statement

The information disclosure statement filed 10 March 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because not all documents have either an English translation or Abstract to show relevance. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

The examiner would like to point out that it has been held in the courts that the "applicant has [an] obligation to call the most pertinent prior patent to [the] attention of [the] Patent Office in a proper fashion." [*Penn Yan Boats, Inc. V. Sea Lark Boats, Inc.,*

et al. 175 USPQ 260 (DC SFla 1972)]. The examiner would appreciate the applicant identifying why the cited reference is pertinent including relevant portions of the document cited.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10-17, 45-51, 54-57 and 60-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 5,952,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because the final product of the subject patent embraces a coating comprising a thermoplastic resin to which has been added cellulosic fiber, "sheared to the extent that the internal fibers are substantially exposed (claim 11 of the patent)," which embraces that claimed herein. The production of articles is expected of the patented invention, and the composites appear to be essentially identical. The source of the cellulose/lignin cellulose is within the recitations of the patented claims broadly.

Claims 1-8, 10-17, 45-51, 54-57 and 60-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 6,448,307. Although the conflicting claims are not identical, they are not patentably distinct from each other because the final product of the subject patent embraces a coating comprising a thermoplastic resin to which has been added cellulosic fiber, "sheared to the extent that the internal fibers are substantially exposed (claim 1 of the patent)," which embraces that claimed herein. The production of articles is shown in the patented invention, and the composites appear to be essentially identical. The source of the cellulose/lignin cellulose is within the recitations of the patented claims broadly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 10-17, 45-51, 54-57 and 60-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laver, cited and for the reasons set out above.

The reference to Laver teaches the identical product composites at column 6 (lines 13-24), the Abstract, column 8 (lines 18 et seq) and the claims. Note column 6

(lines 29-40) for the recitations of claims 3 and 5. Note column 6 (lines 48-64) for the recitations of instant claims 9-13, including a ratio of components of 80 to 20 to 100 to 0, and preferably 50 to 50. the flexural stress values would be inherent in the product of Laver, as recited in instant claims 15-17, since the compositions are otherwise identical

The reference does not teach any particular cellulose source. Choice of a cellulose source, as recited in instant claims 4 and 6-8, would be a clear modification to one having an ordinary skill, especially in view of the teaching in Laver at column 6 (line 30), in reference to "any kind of waste cellulosic material." Likewise, the manipulation of the size of the fiber, and the subsequently larger exposed surface area, would have been an obvious modification to an artisan in view of the teachings of the patent.

Response to Arguments

Applicant's arguments filed 10 March 2006 have been fully considered but they are not persuasive.

The reference to Laver teaches at column 8 (lines 19-29) that the "cellulosic fiber and thermoplastic raw materials are first shredded according to methods known in the art" and that a "range of sizes" with "both coarser and finer materials" are contemplated. The "range of sizes" would embrace the recitations of the instant claims since a skilled artisan would know, from the reference, that a "range of sizes" produced from fibers would include chopped fibers that may and may not be fibrous or particulate depending upon when such comminution ceases. Clearly, some fibrous materials are taught with

these recitations. Applicants have failed to show any unexpected results as being drawn thereto, especially in view of the fact that identical constituents are taught in Laver.

Submission of a timely filed Terminal Disclaimer has not occurred to overcome the reasons for the rejection of the claims over US Patent Nos. 5,952,105 and 6,448,307 under the judicially created doctrine of obviousness-type double patenting.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

4 May 2006